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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,338	11/04/2000	Francis X. Smith		6208

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EXAMINER

LOVERING, RICHARD D

ART UNIT PAPER NUMBER

1712

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/106,338

Applicant(s)

SMITH ET AL

Examiner

LOVERING

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on NOV. 4, 2002 & PETITION GRANTED NOV. 27, 2002.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-39 is/are pending in the application.
- Of the above claim(s) 14-35 AND 37-39 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-13 AND 36 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-39 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be renumbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 35 on last page of claims has been renumbered 36.

2. Applicant's election without traverse of the species "Bis-Tris and its salts" in Paper No. 10 in addition to a telephone conversation on Jan. 27, 2003 is acknowledged.

Claims 14-35 and 37-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected species as to the buffer. Election was made **without** traverse in Paper No. 10. (See also above sentence).

3. Note that method claims 10-13 should depend upon method claim 8 (instead of solution claim 7) and are being treated as if they did in applying the prior art in this action.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed

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publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 8 and 10 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated or at least anticipated by Matsumoto et al. 6,126,706, esp. Example 1, using Diluents No. 1, 4 and 5 and noting column 4, line 66 - column 5, line 5 as to the bacteria growth inhibitory effect of EDTA or its salts; and Example 5 as to treating contact lenses, and noting column 7, lines 13-58 as to the container and lid.

7. Claims 1, 2, 4-7, 9, 11, 12 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumoto et al. above.

The especially pertinent portions of Matsumoto et al. are pointed out in the preceding paragraph. While Examples 1 and 5 of Matsumoto et al. may not state that the pH is between 6.5 and 7.8, as to claims 1, 4-7 and 36 herein, it would have been

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obvious to one skilled in the art at the time applicants' invention was made to choose a suitable or optimum pH or pH range within that of 6.0-8.0 taught by patentees in column 5, lines 52 and 53. In this connection, see In re Aller et al., 220 F. 2d 454, 105 USPQ 233. As to claims 2 and 5 herein, it would have been obvious to one skilled in the art at the time applicants' invention was made to adjust the tonicity to the range of 200-350 mOsm because patentees (column 5, lines 55-61, esp. line 6<sup>1</sup>) teach this is preferable. As to claims 9, 11 and 12 herein, the use of POE (40) hydrogenated castor oil or other POE hydrogenated castor oils or POE castor oils in lieu of POE (60) hydrogenated castor oil in Examples 1 and 5 of Matsumoto et al. is rendered prima facie obvious by the interchangeability of these nonionic surface active agents by patentees in column 5, lines 11-30.

8. Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumoto et al. in view of Inoue 5,891,733.

The especially pertinent portions of Matsumoto et al. are pointed out in paragraph 6 above. While Matsumoto et al. do not disclose the use of Bis-Tris as a buffer, it would have been obvious to one skilled in the art at the time applicants' invention was made to use in lieu of the boric acid/borate buffer in Examples 1 and 5 of Matsumoto et al., the Bis-Tris buffer of Inoue (column 4, lines 6-10) who teaches this buffer is capable

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of providing a "more preferable" pH of 6.8 to 7.2 (column 4, lines 3 and 4).

9. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 6, 7 and 9-13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

a) Claims 6 and 7 recite Markush groups which are not considered proper for the reasons that they are indefinite as to scope and incomplete as to their memberships in reciting "or" instead of --and-- between their penultimate and last members. (Claim 6 also improperly recites "or" between the fourth and fifth members.);

b) method claims 10-13 are indefinite and improper and fail to properly point out the invention in depending upon solution claim 7 instead of method claim 8; and

c) claims 9 and 11 are substantial duplicates, each of the other.

11. Claims 1-4, 6, 8 and 36 are objected to because of the following informalities: Claims 1 and 4 need to recite a period after their last word or expression; claims 1-3 need to recite

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--and-- after "glyceride;" in line 2; and claim 36 needs to recite --and-- after "glyceride;" in line 5. Also, the misspelled words "riciinoleate" and "gycerol" in claim 6, line 6 and "precent" in claim 8, line 2 need to be corrected.

Appropriate correction is required.

12. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the earlier filed application(s) in the first sentence of the specification (37 CFR 1.78).

13. The disclosure is objected to because of the following informalities: There is a hiatus on page 1 of the specification between lines 12 and 13.

Appropriate correction is required.

14. Doi et al. 6,432,893 and WO 00/11514 are pertinent, but not applicable under 35 U.S.C. § 102(e) as amended 1999/2002.

15. The remaining references listed on the attached Form PTO-892 are cumulative to the references applied herein, and/or further show the state of the art.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc  
January 28, 2003

*Richard D. Lovering*  
RICHARD D. LOVERING  
PRIMARY EXAMINER  
GROUP ~~100~~ 1702